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OFFICE OF PETITIONS

DECISION ON PETITION

In re Application of
Geoffery M. Thiele, Thomas L. McDonald,
Dean J. Tuma, Lynell W. Klassen, and
Mitchell F. Sorrell
Application No. 09/318,080
Date Deposited: May 25, 1999
Attorney Docket No. P00645US2-63
Title: NOVEL ACETALDEHYDE AND
MALONDIALDEHYDE PROTEIN
ADDUCTS AS MARKERS FOR ALCOHOL
LIVER DISEASE

This is a decision on the "Petition for Decision on a Question not Specifically Provided for under 37 CFR §1.182"¹, filed June 6, 2002, requesting that the above-identified application be accorded a filing date of April 8, 1997, with the specification submitted with the instant petition as part of the original disclosure of the application.

The application was filed on May 25, 1999. However, on March 25, 2002, Initial Patent Examination Division (OPE) mailed a notice stating that the application had not been accorded a filing date, and advising applicants that the application was deposited without a specification. The notice further stated that a new oath or declaration would be required, and that a filing date would be accorded upon the receipt of a specification.

Petitioners allege that the specification was indeed filed with the application². Petitioner further states that the instant application is a divisional of parent application 08/817,018,

¹ This is properly treated as a petition under 37 CFR 1.53(b).

² It is noted that no postcard receipt or declaration of facts has been submitted to support this allegation. Petitioner has included the Utility Patent Application Transmittal (Form PTO/SB/05) to serve as proof that a specification has been submitted. The specifications submitted with the instant petition are 57 and 26 pages in length, and neither contains the claims. PTO/SB/05 states that a 36 page specification was submitted, including the claims. As this does not match what was submitted with this petition, it cannot serve as persuasive evidence.

which has issued as patent number 5,939,535. Petitioner further states that the parent application was incorporated by reference in its entirety into the instant application³. Petitioner has further submitted a preliminary amendment, a fifty-seven (57) page specification as originally filed, a statement that the substitute specification contains no new matter, and a twenty-six (26) page substitute specification.

Petitioners have further submitted a copy of the declaration associated with PCT/US96/17833.

Regarding the substitute specification, it has been determined that the MPEP does indeed provide a solution to petitioner's dilemma. The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identified this application as a divisional of prior application No. 08/817,018, and specifically incorporated by reference the disclosure of the prior application. Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

Petitioner has correctly supplied a preliminary amendment, which supplies the missing specification for this case. This amendment must be reviewed by the examiner for new matter⁴. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

Petitioner has set forth that the 57 specification submitted with the instant petition is a true and exact copy of that which was submitted upon filing. It is further noted that the 26 page specification is an exact copy of the parent's specification. Therefore, the specification which was allegedly included on filing is NOT the same specification as included in the parent. Were it not for petitioner's incorporation by reference of the specification of the parent, this petition would not be granted.

³ Petitioner has included a copy of the Utility Patent Application Transmittal, which indicates that the entire disclosure of the parent application is incorporated by reference, and the petitioner has attested on his registration number that the substitute specification which has been supplied contains no new matter.

⁴ See MPEP 608.02(a).

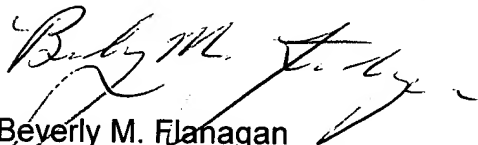
Regarding the declaration which has been submitted with the petition, it is noted that it is a duplicate of the copy supplied on June 29, 1999. This declaration is the declaration which was filed in the PCT, and as such, it is not clear why this has been submitted. Petitioner is correct in stating that a new declaration is not needed for this divisional, as the specification which has been submitted is identical to that of the parent⁵.

For these reasons, the petition under 37 CFR 1.53(b) was not necessary, and is dismissed.

Petitioners have requested that the petition fee of \$130.00 be refunded. However, this request will not be granted, as this petition was not necessitated by any error on the part of the Office.

The Application is being forwarded to Technology Center 1600, for consideration of the preliminary Amendment filed with the instant petition.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

⁵ See 37 C.F.R. 1.53(d).